

REMARKS

Claims 1-55 and 57-65 are pending in this application. Claims 1-55 and 62-65, which were previously withdrawn from consideration, are herein cancelled without prejudice or disclaimer. Claim 57 was amended and claim 56 cancelled in the Applicant's prior Amendment mailed May 6, 2003 in Response to the Office Action dated November 6, 2002 (paper no. 13). The amendments to the claims were made to expedite prosecution and not for reasons of patentability. With respect to all amendments and cancelled claims (and/or subject matter related thereto), Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any such subject matter in future continuation and/or divisional application.

New claims 66-73 have been added. Support for the new claim may be found throughout the specification and in the claims as originally filed. For example, support may be found at page 18, lines 12-21 and original claim 56. Thus no new matter has been added by this amendment. Reconsideration of the application in view of the following is respectfully requested.

Correction of Inventorship Pursuant to 37 CFR § 1.48(b)

The currently named inventors of the subject application are Harold S. Bernstein and Shaun R. Coughlin. Applicant respectfully requests that Shaun R. Coughlin be deleted as an inventor. During prosecution of the application cancellation of certain claims has resulted in the invention of Shaun R. Coughlin no longer being claimed. This request is accompanied by the appropriate fee under 37 CFR § 1.17(i).

Rejections under 35 U.S.C. § 102(a)

The Office has rejected claims 56-61 as allegedly being anticipated by Lei *et al.* (*J. Cell Sci.* 113: 4523-4531, 2000). Specifically, the Office contends that "the inventive entity on the instant application is different than that listed on the article recited as prior art." (Office Action, page 4). Applicants respectfully traverse for the reasons presented previously and amplified below.

Applicants note that Harold S. Bernstein, an author on the Lei *et al.* article, is also an inventor on the subject application. The co-authors on the Lei *et al.* article are Xiang-He Lei, Xun Shen and Xiao-Qin Xu. The attached declaration of inventor Harold S. Bernstein states that Xiang-He Lei, Xun Shen and Xiao-Qin Xu were technicians in his laboratory and the work they performed relating to hCdc5 nucleic acid binding sites was done under his supervision and direction and that they did not make any independent contributions to the work. *See* Declaration of Harold S. Bernstein, paragraphs 5-10. Thus, this reference is unavailable for purposes of a rejection against the instant case under §102(a). Applicants respectfully request withdrawal of this rejection.

CONCLUSION

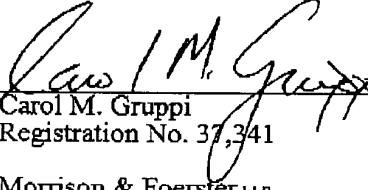
Applicants respectfully submit that all objections and rejections have been overcome and/or rendered moot and that the presently pending claims are in condition for allowance. Should the Examiner believe any issues remain unresolved, he is invited to telephone the undersigned at (650) 813-5777 to discuss such concerns and/or arrange for an interview in order to continue with an expeditious prosecution of this application.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 220022001720.

Respectfully submitted,

Dated: July 24, 2003

By:


Carol M. Gruppi
Registration No. 37,341

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5777
Facsimile: (650) 494-0792